

REMARKS

In the Office Action¹, the Examiner took the following actions:

rejected claims 7, 9-12, 14-17, 36, 38-41, 43-46, and 51-53 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,761,621 to Sinton ("Sinton") in view of U.S. Patent No. 5,740,231 to Cohn et al. ("Cohn"); and

rejected claims 1-6, 8, 13, 30-35, 37, 42, 47-50, and 54 under 35 U.S.C. § 103(a) as being unpatentable over Sinton in view of Cohn and further in view of U.S. Patent No. 5,805,666 to Ishizuka et al. ("Ishizuka").

By the present amendment Applicant amends claims 1, 3, 7, 12, 30, 32, 36, 41, and 51. The amendments are supported by the application as filed; see, for example, at least page 23, line 22 to page 24, line 2 and/or Figure 4; no new matter is added. Claims 1-17 and 30-54 remain pending in this application.

Rejections of Claims 1-17 and 30-54 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 7, 9-12, 14-17, 36, 38-41, 43-46, and 51-53 under 35 U.S.C. § 103(a) as being unpatentable over Sinton in view of Cohn because a prima facie case of obviousness has not been established with respect to the claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. "A conclusion of

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P.* § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P.* § 2143.01(III), *internal citation omitted*. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *M.P.E.P.* § 2141.02(I), *internal citations omitted* (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." *M.P.E.P.* § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." *M.P.E.P.* § 2141(III).

Independent claim 7 recites "[a] method of accessing an information system using a portable access device" including, among other steps, "identifying a communication profile associated with said network server, the communication profile including description information corresponding to **a data compression format and a forward error correction toggle**" and "establishing a communication link between said

portable access device and said network . . . , and establishing the communication link includes using at least **a portion of the description information.**" (Emphasis added).

On page 4 of the Office Action, the Examiner concedes that *Sainton* does not explicitly teach "a communication profile . . . and establishing a communication link between said portable access device and said network server using a communication channel that is selected based on said communication profile." The Office Action relies on *Cohn* to overcome this deficiency of *Sainton*. *Cohn*, however, also does not teach or suggest a "communication profile including description information corresponding to a data compression format and a forward error correction toggle" and "establishing a communication . . . using at least a portion of the description information."

Cohn is directed to "a communication system 10 [that] maintains a universal database of all users of the communications system and their individual communications profiles including the various media in which the users can send and receive messages. For example, a single user may control and receive communications using an electronic mail facility, a voice mail facility, a facsimile facility and a video facility." (*Cohn*, col. 7, line 62-col. 8, line 7). In *Cohn*, network hubs 12, 14, and 16 use the universal database to translate a message in accordance with the communication profiles and the translated message is then routed to a destination facility. (*Cohn*, col. 8, line 6-col. 9, line 12). Further, *Cohn* discloses "a directory with which it offers a range of addressing and directory services . . . [and] includes routing information and feature parameters." (*Cohn*, col. 24, lines 45-52).

Thus, *Cohn* discloses the use of a communication profile and directory to translate and route messages to a destination facility. The communication profile or

directory of *Cohn*, however, does not constitute the claimed "communication profile."

This is at least because the communication profile or directory of *Cohn* does not include "description information corresponding to a data compression format and a forward error correction toggle," as recited in claim 7. In contrast, the communication profile and directory of *Cohn* merely include routing information, feature parameters, and addresses of destination facilities, none of which constitute "description information corresponding to a data compression format and a forward error correction toggle."

Moreover, because *Sainton* and *Cohn* do not disclose a "communication profile including description information corresponding to a data compression format and a forward error correction toggle," *Sainton* and *Cohn* also cannot teach or suggest "establishing a communication link between said portable access device and said network . . . , and establishing the communication link includes using at least **a portion of the description information**," (emphasis added) as further recited in claim 7.

Thus, *Sainton* and *Cohn* do not teach, suggest, or render obvious the features of claim 7.

Accordingly, for at least the above reasons, the Office Action has not established a *prima facie* case of obviousness for claim 7. Thus, the rejection of claim 7 under 35 U.S.C. § 103(a) should be withdrawn.

Independent claims 12, 36, 41, and 51 while of different scope, recite features similar to those of claim 7 and are thus also allowable over *Sainton* and *Cohn* for reasons similar to those presented above for claim 7. For example, claim 12 includes "identifying a communication profile associated with said second network server, the communication profile including description information corresponding to a data

compression format and a forward error correction toggle;" claim 36 includes "identifying a communication profile associated with said network server, the communication profile including description information corresponding to a data compression format and a forward error correction toggle;" claim 41 includes "identifying a communication profile associated with said second network server, the communication profile including description information corresponding to a data compression format and a forward error correction toggle;" and claim 51 includes "identifying, by the access device, a communication profile associated with a first server, the communication profile including description information corresponding to a data compression format and a forward error correction toggle;" features that are not taught or suggested by *Sainton* and *Cohn*.

Claims 9, 10, 11, 14-17, 38-40, 43-46, 52, and 53 are also allowable at least due to their dependence from one of the independent claims.

Applicant respectfully traverses the rejection of claims 1-6, 8, 13, 30-35, 37, 42, 47-50, and 54 under 35 U.S.C. § 103(a) as being unpatentable over *Sainton* in view of *Cohn* and further in view of *Ishizuka* because a prima facie case of obviousness has not been established.

Independent claims 1, 3, 30, and 32, while of different scope, recite features similar to those of claim 7. For example, claim 1 includes "identifying a communication profile associated with a first network server, the communication profile including description information corresponding to a data compression format and a forward error correction toggle;" claim 3 includes "retrieving the communication profile from the second network server, the communication profile including description information corresponding to a data compression format and a forward error correction toggle;"

claim 30 includes "identifying a communication profile associated with a first network server, the communication profile including description information corresponding to a data compression format and a forward error correction toggle;" and claim 32 includes "retrieving the communication profile from said second network server, the communication profile including description information corresponding to a data compression format and a forward error correction toggle," features that are not rendered obvious in view of combinations of *Sainton* and *Cohn* for at least the above discussed reasons.

In addition, *Ishizuka* fails to cure the above-noted deficiencies of *Sainton* and *Cohn*. Thus, independent claims 1, 3, 30, and 32, and dependent claims 2-6, 8, 13, 31, 33-35, 37, 42, 47-50, and 54 are allowable over the cited references.

Accordingly, reconsideration and withdrawal of this rejection of claims 11-6, 8, 13, 30-35, 37, 42, 47-50, and 54 under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

CONCLUSION


In view of the foregoing amendment and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Philip J. Hoffmann
Reg. No. 46,340

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
901 New York Avenue, N.W.
Washington, D.C. 20001-4413
(202) 408-4000